

REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

Preliminary Comments

Independent Claims 101 and 135 has been amended to change “non-biologic material” to “material.” Dependent claims 185 to 188 have been added and recite “biologic” and “non-biologic.”

Rejection under 35 U.S.C. 112, first paragraph Enablement

Claims 101-106, 108-123, 132/101, 132/102, 132/105, 133, 134, 135, 145/135, 148, 152, 153, 156, 157, 166, 167, 176, and 177 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Applicants respectfully disagree. Since Applicant has amended independent claims 101 and 135 to delete the term “non-biologic” the rejection is moot as applied to the terms “biologic” and “non-biologic.” But since dependent claims 185 to 188 have been added and recite “biologic” and “non-biologic” Applicants assume this rejection will be asserted against these claims. Applicants disagree

The Examiner states:

The specification of the instant application only gives examples of laser ablation of chromium (page 7 of specification), gold (page 12 of specification), silver film on glass (page 13 of specification), SiO₂ (glass) (page 15 of specification), cornea (page 16 of specification). There is no disclosure of the material genus being "non- biological" as claimed in claims 101-106, 108 -123, 132/101, 132/102, 132/105, 135, 145/135, 157, 167, and 177 of the material genus being "non-organic" as claimed in claims 133, 134, 152, 156, 166, 176, of the material genus being "organic" as claimed in claim 153.

Applicants respectfully disagree. A cornea is organic and glass, silver, gold and chromium are non-organic and non-biological. Thus applicants have disclosed organic, non-organic, biological and non-biological materials. Moreover, applicants respectfully believe that the Examiner's statement "There is no disclosure of the material genus being "non- biological" as claimed in claims 101-106, 108 -123, 132/101, 132/102, 132/105, of the material genus being "non-organic" as claimed in claims 133, 134, 156, 166, 176, of the material genus being "non-organic" as claimed in claims 135, 145/135, 157, 167, and 178" is incorrect since applicants' specification disclose biological and non-biological species and generically describe their invention being applicable to any material. The genus material is composed of a biological genus and a non-biological genus. Applicants respectfully disagree with the Examiner's statement "Applicant cannot successfully argue that Applicant by having examples of the genus is entitled to claim the entire genus." The Examiner has not made out a *prima facie* case for lack of enablement. The Examiner has given no reason for why a person of ordinary skill in the art cannot practice applicants' claimed invention without undue experimentation. In view of applicants' remarks the Examiner is respectfully requested to withdraw the rejection of claims 101-106, 108-123, 132/101, 132/102, 132/105, 133, 134, 135, 145/135, 156, 157, 166, 167, 176, and 178 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner further states:

"Regarding claim 148 there is no disclosure in the originally filed instant application of a "metallic material transparent to radiation" as recited in claim 148 on line 2 but instead only of a metallic material (gold) being opaque to radiation and another embodiment in which the transparent material (SiO₂).

Applicants respectfully disagree. Support is found in the parent application in originally filed claim 5 which recites "wherein the material is transparent to radiation emitted by the laser."

Rejection under 35 U.S.C. 112, first paragraph, Written Description

Claims 101-106, 108-123, 132/101, 132/105, 133, 134, 135, 145/135, 152, 153, 156, 157, 166, 167, 176, and 177 have been rejected e rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully disagree. Applicants respectfully disagree. Since Applicant has amended independent claims 101 and 135 to delete the term "non-biologic" the rejection is moot as applied to the terms "biologic" and "non-biologic." But since dependent claims 185 to 188 have been added and recite "biologic" and "non-biologic" Applicants assume this rejection will be asserted against these claims. Applicants disagree

The Examiner states:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification provides no support for the respective genuses of laser ablation of "non-biological material" as recited in claims 101-106, 108-123, 132/101, 132/102, 132/105, 135, 145/135, 157, 167, and 177, "non-organic material" as recited in claims 133, 134, 152, 156, 166, and 176 or "organic material" as recited in claim 153 but merely examples of laser ablation of chromium, gold, silver film on glass, SiO₂, and a cornea.

Applicants respectfully disagree. A cornea is organic and glass, silver, gold and chromium are non-organic and non-biological. Thus applicants have disclosed organic, non-organic, biological and non-biological materials. Moreover, applicants respectfully believe that the Examiner's statement "There is no disclosure of the material genus being "non- biological" as claimed in claims 101-106, 108 -123,

132/101,132/102,132/105, 145/135, 157,167, and 177" of the material genus being "non-organic" as claimed in claims 133, 134,156,166 and176, of the material genus being "non-organic" as claimed in claims 135, is incorrect since applicants' specification disclose biological and non-biological species and generically describe their invention being applicable to any material. The genus "material" is composed of a biological genus and a non-biological genus. Thus a person or ordinary skill in the art would recognize the Applicants were in possession of the genus "material" and the subgenus "biological " and the subgenus "non-biological." The genus "material " is composed of an "organic" subgenus and a " non-organic" subgenus. Thus a person or ordinary skill in the art would recognize the Applicants were in possession of the genus "material" and the subgenus "organic " and the subgenus "non-organic." A cornea is a biological and an organic material. The species chromium, gold, silver film on glass, SiO₂ are "non-biological" and "non-organic" materials.

In view of applicants' remarks the Examiner is respectfully requested to withdraw the rejection of claims 101-106,108-123,132/101,132/105,133,134,135, 145/135,152, 153,156, 157,166,167,176, and 177 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement .

Rejection under 35 U.S.C. 103(a)

Obviousness

In response the Examiner's inquiry all claims that were commonly owned at the time a later invention was made i

Claims 101-184 have been are rejected under 35 U.S.C. 103(a) as being unpatentable over Mourou et al. in U.S. Patent No. 5,656,186 in view of Portney et al. in U.S. Patent No. 5,053,171 or Bennin et al. in U.S. Patent No. 5;160,823. Applicants respectfully disagree. In Applicants response dated 02/14/2008 at pages 18 to 23 Applicants

explained why Mourou et al. in view of Portney et al. or Bennin et al. does not make out a prima facie case of the obviousness of the claims rejected as obvious. The Examiner has not responded to this argument nor rebutted this argument. Thus the Examiner has not made out a prima facie case of obviousness. At pages 3 – 13 in one paragraph 6 the Examiner has essentially repeated the arguments of the Office Action of 11/02/20007 with a few additional comments, many of which are to add after a reverence to a claim number from Mourou et al. the location by column and line number this adds not additional arguments to what was in the Office Action of 11/02/2007. Applicants have extensively responded to these arguments in Applicants' responded dated 02/14/2008 – these comments are incorporated herein by reference.

In paragraph 7 of the Office Action starting at page 13 to page 17 the Examiner alleges that the Examiner is responding to Applicants' arguments. Applicants respectfully disagree.

Initially, to further prosecution Applicants claims have been further amended. By so doing Applicants are not agreeing with any of the Examiner's comments of or that the Examiner has in fact established obviousness of the rejected claims.

Each independent claims has been amended to recite "so that the laser beam defines a spot and has a lateral profile characterized in that fluence at or near the center of the beam spot is greater than the threshold fluence whereby the laser induced breakdown is ablation of an area within the spot," or similar recitation. Ther is not teaching, suggestion, motivation or suggestion for this in the cited reverences. A recitation of this type was in claims 124 and 133. The Examiner's comments in paragraph 6 of the Office Action on why the Examiner considered claims 124 and 133 as obvious does not comment on this limitation. The Examiner has provided not argument for why a person of skill in the art would conceive to the invention based on the cited references or by what is know to a person of ordinary skill in the art. The Examiner impermissibly relies on unsupported conslusory statements to reject the claims as obvious. Thus the Examiner has not made out a prima facie case of non-obviousness as to this limitation. Mourou et al. is limited to focusing the laser beam at or beneath the surface. This is a

requirement of the teaching of Mourou et al. A person of ordinary skill in the art would understand this to be a requirement of the teaching of Mourou et al.

Paragraph 7 of the Office Action essentially restates what was stated in paragraph 6 of the Office Action. At page 14, lines 1 - 6, the Office Action states.

It is argued that because Mourou et al. focuses the laser beam at or beneath the workpiece surface one would not be motivated by the teaching of Bennin to adapt the Mourou et al. reference. This is not persuasive since one of ordinary skill in the art is aware that the critical parameter is the fluence level (Joules/cm²).

Applicants respectfully disagree. The Examiner has not identified what the source of the comment "one of ordinary skill in the art is aware that the critical parameter is the fluence level." Applicants respectfully disagree and request the Examiner to provide documentary evidence to support this statement. 37 CFR 104(d)(2) states "[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the office ... the reference must be supported when called for by the Applicants, by an affidavit of such employee." Under 37 CFR 104(d)(2) Applicants requests the documentary evidence that the Examiner must provide or Applicants request that the Examiner provide the affidavit qualifying the Examiner to be sufficiently expert in the art to make this statement on the Examiner's own knowledge. In the alternative Applicants respectfully request the Examiner to withdraw this statement.

In view of the remarks herein applicants respectfully request the Examiner to withdraw the rejection of Claims 101-184 under 35 U.S.C. 103(a) as being unpatentable over Mourou et al. in U.S. Patent No. 5,656,186 in view of Portney et al. in U.S. Patent No. 5,053,171 or Bennin et al. in U.S. Patent No. 5,160,823.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response,

should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Please charge deposit account 09-0468 any fee necessary to enter this paper.

Respectfully submitted,

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